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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,254	06/19/2001	Jan Buckner	027695-00001	5619

7590 06/03/2005

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EXAMINER

LIM, KRISNA

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,254

Applicant(s)

BUCKNER ET AL.

Examiner

Krisna Lim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-32 are still pending for examination.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. The rejections are respectfully maintained and repeated herewith as set forth in the last office action.
4. Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Hsu et al. [U.S. Patent No. 6,295,058].
5. Hsu et al anticipated (e.g., see col. 4, lines 1-14) the invention substantially as claimed. Taking claim 28 as exemplary claims, the reference disclosed a system for updating electronic mail (a user composes a multimedia email message ..., the user

may edit and add email message, see the abstract), the system comprising: a user (630) and a recipient (last 3 lines of the abstract, col. 4 (lines 1-14)) each having access to an electronic mail system; **creating a textual template (e.g., see 605 to 620 of Fig. 6, the abstract, col. 3, lines 12-23, col. 6, line 25, to col. 7, line 8);** (610, col. 4, line 14); recipient information for the textual template (e.g., see col. 4, lines 13-14); and an address book (inherent in a network mail server 340, col. 2, lines 14-15, col. 4, lines 38-39) associated with the electronic mail system wherein the address book contains the recipient information.

6. As to claim 29, Hsu et al. further anticipated a screen display (e.g., see 480, col. 8, line 36).
7. As to claim 30, Hsu et al. further anticipated a prompt on the screen display for assisting the user (e.g., see col. 8, lines 32-34).
8. As to claim 31, Hsu et al. further anticipated means for electronically mailing the template to the recipient (e.g., see the abstract).
9. As to claim 32, Hsu et al. further anticipated a template with information fields (e.g., see col. 6, lines 58-59).
10. As to claims 1-27, they are similar to the claims 28-32 with the additional feature of: a) **creating a textual template (e.g., see 605 to 620 of Fig. 6, the abstract, col. 3, lines 12-23, col. 6, line 25, to col. 7, line 8);** b) editing the textual template (e.g., see col. 8 (line 47), the abstract, 615-635 of Fig. 6); c) customizing specific information provided by the recipient based on user specified requirements (the design template contains one or more slots into which the user may simply drag and drop any desired text, video, or audio data, see the abstract, 615 to 635 of Fig. 6, 1005 to 1025 of Fig. 10); d) updating the electronic database with the edited textual template (e.g., 645 of

Fig. 6, col. 6, line 25, to col. 7, line 8); and e) building the textual template with information fields (e.g., slot of a template, col. 7, line 8-9).

11. Applicant's arguments filed 3/10/05 have been fully considered but they are not deemed to be persuasive.

12. In the remarks, applicants argued in substance that:

a) Hsu is neither comparable nor analogous to the system and method of electronically gathering and incorporating information into data.

b) Hsu fails to disclose or suggest at least creating and/or building a textual template. In fact, column 4, lines 7-8 and the Abstract of Hsu disclose, "selecting a design template, which has previously been created and stored on the system (emphasis added)," and fails to show the process of allowing a user to create and/or build a textual templates as recites in the claims.

13. In response to the paragraph 12 a) above, it is axiomatic that claims are given their broadest reasonable interpretation. Thus, Examiner interprets that "the system and method of electronically gathering and incorporating information into data" is an apparatus and method that allows user to compose by selecting (gathering and incorporating) design template (information) into email message (data).

14. In response to the paragraph 12 b) above, while Hsu., at column 4, lines 7-8, and the abstract, discloses that those design templates had been previous created and stored, it does not means that Hsu does not allow user to create and/or build a textual templates. For example, Hsu discloses the system that allows a user to design a new

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template (e.g., to compose, to edit, to add, to create image, to convert and save the result) from the list of available design templates (e.g., see col. 6, line 26, to col. 8, line 55). And, this is the same concept as in the applicant's claimed language; for example, in claim 1, the applicant also claimed that after a textual template is created, this template is configured, edited, updated (saved) in the database. Therefore, to the extended of the claimed language, Hsu clearly teaches the claimed invention.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Wednesday and Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

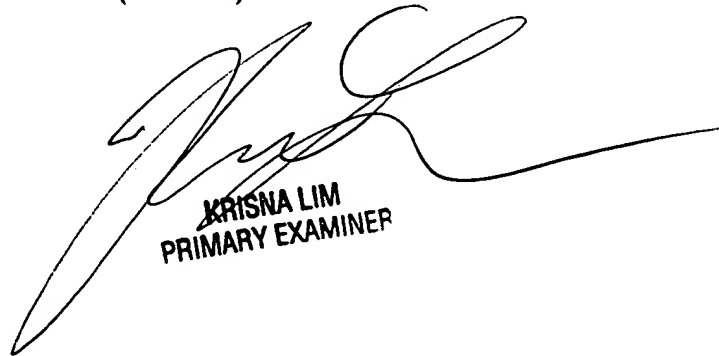
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

May 25, 2005



KRISNA LIM
PRIMARY EXAMINER